Serial No.: 10/680,708

Request for Telephone Interview

Applicant kindly requests the Examiner to contact the undersigned at (847) 490-1400 to schedule a telephone interview, to discuss the merits of this Patent Application.

Claim Rejections - 35 U.S.C. §103

The rejection of Claims 1-7, 14, 16-18, 21, and 22 under 35 U.S.C. §103(a) as being unpatentable over Trimble, U.S. Patent 5,413,371, in view of Houser et al., U.S. Patent 6,916,035, is respectfully traversed.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2142

The combination of the Trimble and the Houser et al. Patents does not teach or suggest all limitations of Claim 1. The Office Action alleges the Trimble Patent teaches Applicant's invention of independent Claim 1, except for "the ski having a plurality of several regions of lower flexibility or higher flexibility alternating in the longitudinal direction" (Page 4). The Trimble Patent also does not teach or suggest the following limitations of Claim 1:

> at least two force introduction regions at a distance from one another in the longitudinal direction for introducing forces from the interface device into the ski;
> ...and
> the middle section of the ski having a region with a higher flexibility, and at least one of a frontmost and a rearmost force introduction region allocated to a region with a lower flexibility of the ski and in the longitudinal direction arranged one of further to the front and further to the rear than the binding region.

The Office Action points to Col. 6, lines 65-68 of the Trimble Patent for teaching a middle section of a ski having a higher flexibility. At Col. 6, lines 65-68, the Trimble Patent states:

> As shown in FIG. 1, the binding block system 16 of the present invention provides for maximum flexibility in the ski 10 by providing a mid region that is highly flexible.

The embodiment discussed in this passage is a binding block 16 that has a gap between two blocks 17a/b. The gap allows for the maximum flexibility in the ski. However, the ski itself in the Trimble Patent is not taught as having a middle section having a region with a higher flexibility, as in Applicant's claimed invention.

The passage cited by the Office Action, when it is read in proper context, teaches one skilled in the art to limit the impact on ski flexibility by the binding, but it does not say that the ski itself is to have a having a middle section having a region with a higher flexibility, as in Applicant's claimed invention. The Office Action applies this cited passage through a lens of hindsight, in that the passage is interpreted in view of Applicant's invention to make the Trimble Patent fit the rejection.

Regarding Applicant's recited "at least two force introduction regions," the Office Action does not provide any element number or cited passage from the Trimble Patent to identify where the prior art teaches the recited force introduction regions. This is, of course, because the Trimble Patent, alone or in combination with the Houser et al. Patent, does not teach or suggest Applicant's recited force introduction regions.

Claim 1 recites that the force introduction regions introduce forces from the interface device into the ski. In Claim 1, at least one of a frontmost and a rearmost force introduction region is allocated to a region with a lower flexibility of the ski, and arranged one of further to the front and further to the rear than the binding region. The Trimble Patent does not teach or suggest such a structure. Referring to FIG. 4 of the Trimble Patent, the binding blocks 17a/b are screwed to the ski beneath the binding blocks 17a/b. As shown in FIG. 1, the binding 12 is over the screws 52. In the Trimble Patent, there is no structure in front of or rear of the binding 12 that could be considered the recited force introduction regions.

The Houser et al. Patent is applied for teaching ski regions of higher and lower flexibility, as well as regions of low flexibility formed as thick regions and regions of high flexibility formed as thin regions. The Houser et al. Patent relates to superelastic components in sporting equipment, such as skis, and does not mention ski bindings (the invention of the Trimble Patent). Thus the combination of the Trimble and the Houser et al. Patents also does not provide the limitations quoted above.

Regarding the Houser et al. Patent teaching regions of low flexibility formed as thick regions and regions of high flexibility formed as thin regions, the Office Action appears to only cites to Col. 2, lines 58-68, for this (page 4). Applicant sees no reference to controlling flexibility with thickness in this passage. The Houser et al. Patent is teaching altering flexibility with superelastic components, not ski thickness.

The Office Action also does not provide a proper suggestion or motivation for combining the cited prior art references. The Office Action states the motivation for the combination of the teachings of the Trimble and Houser et al. Patents is to "eliminate the need for two or more components being connected through a hinge structure that requires pivot points between the two or more components, as taught in column 7, lines 53-58" (page 4, last paragraph). This alleged motivation is directly contradictory to the teaching of the Trimble Patent, which teaches that a rigid one-piece binding inhibits the flexibility of the ski. Applying the teachings of the Houser et al. Patent to the Trimble Patent based upon the stated motivation of the Office Action, thus renders the device of the Trimble Patent inoperable for its intended use as a "hinged" binding.

Applicant has presented several arguments above why the invention of Claim 1 would not have been obvious to one skilled in the art over the combination of the Trimble and Houser et al. Patents. Reconsideration and withdrawal of this rejection are respectfully requested. All other claims depend from Claim 1.

The rejection of Claim 15 under 35 U.S.C. §103(a) as being unpatentable over Trimble, U.S. Patent 5,413,371, in view of Houser et al., U.S. Patent 6,916,035, and further in view of Meatto, U.S. Patent 4,706,985, is respectfully traversed. Claim 15 depends from Claim 1, and is patentable for at least the same reasons as Claim 1 discussed above.

Conclusion

Applicant intends to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicant has not resolved in this response, Applicant's undersigned attorney again requests a telephone interview with the Examiner.

Applicant sincerely believes that this Patent Application is now in condition for allowance and, thus, respectfully requests early allowance.

Respectfully submitted,

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